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EXAMINER

MCCORMICK, SUSAN B

ART UNIT

PAPER NUMBER

1661

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10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/664,247

Applicant(s)

ELSNER, WILHELM

Examiner

Susan B. McCormick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Detailed Action

Status of Application

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections

Claim 1 remains rejected under 35 U.S.C. 102(b) as being clearly anticipated by Plant Breeder's Right Application number 970950 (European Community) in view of Applicant's admission that 'Pendec' was first offered for sale in Europe in July 1998 for the reasons stated in the previous action.

Response to Arguments

Applicant's remarks filed March 18, 2002 have been fully considered but are not considered persuasive for the following reasons:

Applicant argues that in a multiple reference rejection under 35 U.S.C. 102(b), an additional reference may only be relied on to show the primary reference has an enabled disclosure. Additionally, **Applicant argues** that the first reference must disclose every element of the claimed subject matter. No disclosure from the secondary reference may be imported into the disclosure of the primary reference and the secondary reference may only used to demonstrate that the claimed subject matter was available to the public.

The Examiner generally agrees with the Applicant as to the interpretation of *In re Samour* and *In re Donohue*, however the analysis did not go far enough and as a result an important aspect of both cited cases was not apparent in the argument. Respectfully, the Examiner would like to point out how the two cited cases support the rejection that was made under 102(b). As noted in *In re Samour*,

"a printed publication which discloses every material element of the claimed subject matter, would constitute a bar under 35 USC 102(b) to appellant's right to a patent if, more than one year prior to appellant's filing date, it placed [the claimed subject matter] 'in possession of the public.' Whether claimed subject matter was in possession of the public depends on whether a method of preparing the claimed subject matter would have been known by, or would have been obvious to, one of ordinary skill in the pertinent art." 197 USPQ at 3-4 (citations omitted).

The court further noted that the disclosure in the primary reference must be considered together with the knowledge of one of ordinary skill in the pertinent art, and that it is appropriate to rely on additional references solely as evidence that, more than one year prior to appellant's filing date, a method

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of preparing the claimed subject matter would have been known by, or would have been obvious to, one of ordinary skill in the art. 197 USPQ at 4.

As noted by Applicant, *In re Donohue* stands for the propositions that disclosure of a claimed invention in a printed publication will not suffice as prior art if it is not enabling, and that prior art under 35 USC 102(b) must sufficiently describe the claimed invention to have placed the public in possession of it. "Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his own knowledge to make the claimed invention." 226 USPQ at 621.

The Examiner understands that the primary contention of the Applicant is that not every material element is disclosed in the primary reference. However, here, as in *Donohue*, the invention described in the primary reference is identical to the claimed invention. If the reference teaches the invention but does not teach every single **inherent** property of the invention, it still anticipates the claim. As explained in *Donohue*:

"Appellant also argues that the references fail to teach the solubility characteristics and melting point range set forth in dependent claims 25 and 28, respectively. However, where as here, the dicarboxylic acid TMBP and dimethyl ester TMBP of Nomura are identical to the claimed invention, the properties of Nomura's compounds are inherently the same as those of the claimed invention in the absence of proof to the contrary. See *In re Best*, 562 F.2d 1252, 195 USPQ 430, 433-34 (CCPA 1977)." 226 USPQ at 622.

The claim in a plant patent application is drawn to a "plant" as described and illustrated in the specification, i.e., the claim is drawn to a plant with certain inherent characteristics. The cited Plant Breeders' Rights (PBR) document which serves as the anticipatory reference is drawn to the exact same plant as claimed. As a result, the PBR publication teaches each material element of the claim even if the disclosure is not as detailed as an application for plant patent.

As a result, contrary to Applicant's assertions, *In re Samour* and *In re Donohue* support the rejection under 35 USC 102(b). The primary reference teaches every material element of the instant invention and the only reliance on the secondary reference (Applicant's admission that the claimed subject matter was sold more than one year prior to the U.S. filing date) was to show that the claimed subject matter was in the public possession more than one year prior to the filing date of the patent application.

Bristol-Myers Squibb Co.v. Ben Venue Laboratories, Inc. et al., 246 F.3rd 1368, 58 USPQ2d 1508 (Fed. Cir. 2001) as presented by the Applicant, does not have any additional bearing on this case as it concurs with both *In re Samour* and *In re Donohue*.

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The Examiner notes and agrees with Applicant's statements that *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962) and *Ex parte Thomson*, 24 USPQ2d 1618 (Bd. Pat. App. & Inter. 1992) are consistent with *Samour*, *Donohue* and *Bristol-Myers*.

The Examiner's position is not inconsistent with either *In re LeGrice* or *Ex parte Thomson*. In *LeGrice*, the court held that in order for a printed publication to be a statutory bar under 35 USC 102(b), the publication must provide an enabling disclosure. In the words of the court,

"before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in *combination with his own knowledge of the particular art and be in possession of the invention*." 133 USPQ at 372 (emphasis in original).

The court then states that plant publications should not be totally ignored as printed publications; rather the fact that a printed publication must be enabling "requires that the facts of each case be carefully considered to determine whether the description in a the printed publication in question *does in fact* place the invention in the possession of the public" 133 USPQ at 374.

In summarizing the long recognized requirements of a prior publication, the court quotes Robinson on Patents, Sec. 325 as follows:

[To have the effect of a prior publication,] the publication must be: (1) A work of public character, intended for general use; (2) Within reach of the public; (3) Published before the date of the later invention; (4) A description of the same complete and operative art or instrument; and (5) So precise and so particular that any person skilled in the art to which the invention belongs can construct and operate it without experiments and without further exercise of inventive skill. Unless a publication possesses all these characteristics it does not place the invention in the possession of the public. 133 USPQ at 369.

The PBR document that is relied upon by the Examiner is a publication that meets each of these criteria. The application and granting of Plant Breeders' Rights is carried out in a public forum and can be easily accessed through the Internet, CD-ROM, and direct publication by governmental offices in each of the countries that adhere to The International Union for the Protection of New Varieties of Plants, or UPOV (Union Internationale pour la Protection des Obtentions Végétales). The cited PBR document was published more than one year prior to filing in the United States. The citation is drawn to the same plant for which patent was filed. Lastly, the PBR document precisely refers to the species of plant and the name of the plant. Since this plant was sold more than one year prior to the effective filing date of the present application, one skilled in the art would have been able to purchase and propagate the plant "without experiments or further inventive skill". One of even ordinary skill in the art would have been able to reproduce the plant asexually and grow it without experimenting further with the plant in order to obtain the claimed invention. By using the referenced publication, one of skill in the art would have been

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able to contact the Applicant, Breeder, and Title Holder of the plant in question (information included on the referenced publication) and subsequently obtain a plant since it was being marketed by Applicant's own admission. Such a plant would thus have been in the public possession due to information in the publication.

It is generally recognized that ***prior public use and sale of a plant are the avenues by which a plant enters the public domain.*** See, e.g., *LeGrice*, 133 USPQ at 370-71. The Examiner agrees with Applicant that the PBR publication by itself would not be an enabled publication, were the plant not in the public domain. However, the PBR publication when considered in combination with the knowledge of one skilled in the art, i.e., the availability of the plant in the public domain as evidenced by sale of the claimed plant more than one year prior to application for patent, places the plant in the public domain, and therefore is enabled since one skilled in the art would have been able to reproduce that exact same plant through asexual means. *LeGrice* ruled that a publication alone was not enough to put a plant in the public domain. The fact scenario of this rejection does not parallel the facts in the *LeGrice* case because the rejection here is not based on a publication alone. Indeed, *LeGrice* makes it very clear that "Prior public use and sale of a plant are the avenues by which a plant enters the public domain." The PBR publication, together with public availability of the plant, would have allowed a skilled artisan to take the teachings of the cited PBR and combine them with his own knowledge of the art to be in possession of the invention.

Dr. Richard Craig's declaration has been received. The Examiner agrees with Dr. Craig that it is practically impossible to generate the claimed plant from a description thereof in a printed publication, since it is a product of a cross-fertilization of heterozygous parents. However, the rejection is not based on one of skill in the art being able to reproduce a particular plant from a description or a drawing. The rejection is based on the fact that a skilled artisan could take the teachings of the cited PBR document and *in combination with his or her own knowledge of the particular art be in possession of the invention* due to the fact that the instant plant was sold more than one year prior to the filing date of the U.S. application. As explained above, the publication in light of the fact that the instant plant was sold, put the plant in the public domain more than one year prior to the US filing.

Additionally, the Craig declaration does **not** show that the *Thomson* Board was incorrect in concluding that one could buy seeds and obtain the claimed plant. The Examiner is not suggesting that the instant plant can be obtained from the PBR description. Neither did the *Thomson* Board suggest that the plant could be obtained solely from the publication. In both the instant rejection as well as in the *Thomson* case, the public availability is recited as "enabling" the publications. In other words, the teachings of the publications in combination with the knowledge of one of ordinary skill in the art put the

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invention in the public domain. The Craig declaration does not refute that one of average skill in the art would have been able to reproduce the exact same plant as cited in the PBR documents and as claimed in the application for U.S. patent given the fact that the plant was available to the public more than one year prior to filing.

Applicant argues (on page 11 of the reply) that “Anticipatory prior art in a plant patent application does not require a ‘how-to-make’ disclosure, since ‘how-to-make’ is not a component of a plant patent. Therefore, looking to additional reference (here, public availability outside the United States) to show ‘how-to-make’ a plant--how to obtain the plant or that the plant is obtainable--is inappropriate in a plant patent application.”

This argument is not persuasive because it appears to be the exact same argument that was presented in *LeGrice*. The Examiner in *LeGrice* argued that since there was no “how-to-make” requirement in plant patents under 35 USC 112, first paragraph, then the prior art should also not have a similar enabling requirement. The *LeGrice* Court ruled, “In other words, we think Congress, by enacting no exception to 35 U.S.C. 102(b) with respect to patents for plants, intended that it be interpreted the same for plant patents as it has been interpreted in relation to patents for other inventions.” 133 USPQ at 370. The Court reversed the Board and the Examiner precisely because the cited references did not adequately teach how to make the claimed invention. Therefore, anticipatory prior art must meet the same requirements in plant patents as it does in utility patents. Furthermore, an additional reference used to show that the primary reference put the plant in possession of the public is perfectly appropriate to use in a plant case.

Applicant argues that there is no discussion in *LeGrice* about enablement of the printed publication on the claimed rose plant based on any other source, such as public availability of the plant. The Examiner acknowledges that this issue was not directly addressed in *LeGrice*, as there was no evidence of public availability of record in that case.

As stated previously, the issue before *LeGrice* was whether a publication needed to be enabling to be considered prior art in a plant case, and as stated previously, the Court decided that the publication presented to them was not enough to put the invention in the public domain. However, public use and sale of a plant does put it in the public domain.

In attempting to distinguish the present case from *Ex parte Thomson*, **Applicant again argues** that a utility claim must be fully enabled whereas there is no such enablement requirement of a plant patent claim. Thus, it was appropriate for the Board in *Ex parte Thomson* to consider whether a disclosed seed was publicly available since the claim thereto required public availability of the seed. Applicant

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further argues that the standard for anticipation by a printed publication should be more broadly applied to the claims in a utility application than to a claim in a patent application (page 14 of the reply). Applicant further argues on page 15 that “the *LeGrice* court was unconcerned for the availability of the claimed plant.”

The Examiner disagrees. *In re LeGrice* as well as 35 USC 161 and 37 CFR 1.161 clearly state that the same laws and rules relating to applications for utility patents also are applicable to patents for plants except for the one exception set forth in 35 USC 162. As a result, the standard for anticipation in a plant patent is the same as the standard for anticipation in a utility patent.

The question decided in *LeGrice* was, “Do publications have to be enabled to be considered as prior art under 35 USC 102 for plant patents?” The answer was a resounding “Yes!” However, as noted previously, there was no evidence of public availability of the plant described in the reference publication in *LeGrice*, and therefore that issue was not before the court or addressed by the court in its decision.

Applicant further argues that every material element of the *Thomson* claim was set forth in the primary reference and that the additional reference was cited solely to show that the plant material was in the public domain. As such, the combining of a PBR application with public availability of a plant under 35 U.S.C. 102(b) is improper in a plant application.

This argument has already been discussed above, however, the Examiner would like to additionally point out that in *Ex parte Thomson*, the Board did not state that a full disclosure of the plant was required in the publication. Mere fact of the full disclosure was made to address the question as to whether the references were indeed drawn to the same plant. The *Thomson* decision states, “...we concur with the examiner that the claimed subject matter was described in a printed publication under circumstances whereby it was in the possession of the public more than one year prior to the filing date of the present application.” 24 USPQ2d at 1620. The Board further states, “Manifestly, it is reasonable to conclude that, at the time the cited articles were published, skilled artisans throughout the world would have found Siokra seeds readily available on the open market.” *Id.*

Applicant argues that every material element of the claimed subject matter does not exist in the primary reference of the PBR application, and that the instant plant could not be reproduced from the reference. Applicant argues that this contrasts with *Ex parte Thomson* because the descriptive words of the specification before the Board did not differ substantially from the disclosures of the cited publications. The argument concludes that there is a large difference between the instant specification and the cited PBR documents because the two differ substantially from each other in contrast to the

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specification and publication discussed in *Ex parte Thomson*. As a result, every material element of the claimed subject matter does not exist in the PBR references.

The Examiner disagrees. The completeness of the description was not an issue in the *Thomson* case. Rather, it was used to document that there was no disagreement as to whether the claimed plant was a different plant from the plant cited in the reference. The instant case is similar in that there is no disagreement that the PBR publications reference the claimed plant. The fact that the referenced plant is the same as the claimed plant automatically confers that every material element of the claimed subject matter existed in the reference because those characteristics not specifically disclosed are inherent. The issue decided in *Ex parte Thomson* was that if deposit (availability) of the plant enabled the specification, then availability also enabled the publications. It is the availability of the plant cited in *Thomson* that is important, not the description of the plant. In this case, there is no dispute that the PBR publications reference the same plant. Additionally, the availability of the claimed geranium plant enables the cited PBR publications. Based solely on the reference, a skilled artisan would have been able to buy a geranium plant named 'Pendec' which would have been the exact same geranium plant as described in the application for patent. The Examiner readily admits that the plant cannot be reproduced from the reference except for the fact that sale of the invention put the invention in the public domain. As a result, the **material elements** and the "as complete as is reasonably possible" standards are separate and distinct issues from each other. The Examiner agrees that the PBR publications do not meet the "as complete as is reasonably possible" standards of a US application, but they do contain the **material elements** necessary to put the invention in the public domain in light of the fact that the plant was available to the public. Applicant has not pointed out how the admission that the instant plant has been sold makes up for any particular "deficiency" in the cited publications. The rejection is not combining references using motivation, nor is it improperly combining "on sale in the United States" with a publication, rather the sale of the plant is used to show that the publication was "enabled" and that the plant was in possession of the public under 35 U.S.C. 102(b) in keeping with *In re Samour*, *In re Donohue*, *In re LeGrice*, and *Ex parte Thomson*.

A § 102(b) printed publication can be published and enabled anywhere in the world. It does not matter that the plant is available only outside the United States more than one year before the U.S. filing date. The enablement need not occur in the U.S.

Applicant argues that the PBR is an incomplete document, but the Craig declaration says that no amount of description would have been enabling. The plant material must be available for the public to have possession. Applicant admits that the plant material was available. Once a reference teaching a

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product appearing to be substantially identical is made the basis of a rejection, and the Examiner presents evidence or reasoning tending to show inherency, the burden then shifts to the Applicant to show an unobvious difference (see MPEP 2112). As a result, the applicant needs to prove that the prior art products do not necessarily or inherently possess the characteristics of the claimed product.

Finally, **Applicant argues** that the USPTO cannot have it both ways of asserting a PBR application as enabling prior art and rejecting reasonably detailed plant patent applications for lack of enablement.

A PBR application is enabled as prior art if it sufficiently describes the claimed invention to have placed the public in possession of it. That this is the case in this instance has been argued extensively above. In response to the second part of the argument, the Examiner would like to point out that the Office does not reject plant patent applications for lack of enablement. In fact, it is recognized that the mere description of a plant no matter how detailed it might be does not constitute an enabling description because it does not put the public in possession of the plant. It appears that the Applicant was actually complaining about the amount of detailed information required to make the patent application as complete as is reasonably possible. This has no bearing on the rejection under 35 USC 102(b) and will not be discussed here in detail. In fact, in this instance, Applicant chose instead to supply the information, at least implying that such descriptive details were reasonably possible to obtain.

Conclusion

Argument:

The PBR does not disclose every material element of claim 1: it is not an “enabling” reference.

Response:

Applicant should not confuse the disclosure requirements of 35 USC 162 (“as complete as is reasonably possible”) with the “every material element” test of anticipation under 35 USC 102(b). While the PBR information is not “as complete as is reasonably possible” for the standards of a U.S. patent application, every material element of claim 1 is contained therein, i.e., the PBR publication discloses the exact same invention as the application for patent, and there is no evidence of record to the contrary.

Argument:

The description in the PBR application is so vague that it cannot be read to describe a particular plant variety.

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Response:

The PBR application references a geranium named 'Pendec' produced by Elsner Pac Jungpflanzen. There is no issue as to whether the plant disclosed by the PBR is the same as the presently claimed plant; they are the same plant. This in combination with the fact that this plant was for sale would have enabled one skilled in the art to produce the instant plant.

Argument:

The PBR application's scant disclosure may not be supplemented by an additional reference to supplement what the PBR fails to disclose; an additional reference can only be used to show that the plant disclosed in the PBR application is in the public domain.

Response:

Agreed. That is precisely what this rejection does. The PBR reference in this case is supplemented with Applicant's admission that the plant was for sale, thus showing that the plant disclosed in the PBR was in the public domain more than one year prior to filing in the United States. Characteristics of the claimed plant that are not specifically disclosed in the PBR are inherent properties of the claimed plant.

Argument:

Plant patent applications do not have the "how-to-make" requirement of utility patent applications; hence, no consultation of an additional reference on "how-to-make" (or obtain) the claimed plant variety is needed nor is it proper to do so.

Response:

While it is true that an exception with respect to 35 USC 112 exists for plant patents, this has no bearing on the enablement of a reference. The "exception" of 35 USC 162 does not apply to prior art (*In re LeGrice*). The additional reference of Applicant's admission that the plant was for sale is to show that the published reference is enabling, i.e., one skilled in the art would have been able to make the plant, thus putting it in the public domain.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick whose telephone number is (703) 305-1682. The Examiner can normally be reached Monday through Thursday from 7:00 a.m. to 4:30 p.m. and alternate Fridays from 7:00 a.m. to 3:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 308-0196.

sbm


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